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EXAMINER
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PIERCE, WILLIAM M

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3711

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/396,531  
Filing Date: September 15, 1999  
Appellant(s): ADDINGTON ET AL.

\_\_\_\_\_  
Joel Rosenblatt  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/4/05 appealing from the Office action mailed 1/26/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

This case is also related to 09/396,530 which is also on appeal with an examiner's answer written 11/30/04.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

1. Claims 40-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claims 33, 34, 36, 38-43 and 45-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowble.

3. Claims 35, 37, 44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowble in view of Pratt.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

617,929	Fowble	1-1899
5,881,388	Pratt	3-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

Claims 40-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 40 and 42, the scope of "maximum natural force" is indefinite. The term maximum relates to the intended use, by the strength of an individual, by the delivery of the ball and the weight of the ball. Such a variable is subjective. Claim 43 is inapt in that it fails to positively recite structure such that one can determine the metes and bounds of the claim. Currently the claim is only narrative with functional recitations that fail to further limit the elements in the previously recited claims.

The core of 112 is that the metes and bounds of the claims must be determinable. If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). As factually stated by the examiner to applicant, "the term maximum...is subjective" and in being so, imprecise rendering one incapable of determining the metes and bounds for the claims.

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Likewise with respect to claim 43, one cannot determine the structure required by something that is "adapted to spread said force...substantially uniformly". Again one would not be able to determine the metes and bounds for this claim.

As to, "maximum natural force", ball weights and bowlers are variables without defined ranges. Further the "force" is also a function of how a ball is delivered or thrown. As bowler who rolls a ball straight the pins would produce different forces than when he applies spin to the ball. What would be considered to be "substantially rigid" under these condition remains indefinite. Note that a claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). As with here both the bowling ball and bowler are or unspecified characteristics and render the claim indefinite. Further the limitations in a claim must be timeless. The relationship between the ball, bowler and finger pad shield, the product it identifies, is indefinite, uncertain, and arbitrary since the formula or characteristics of the product may change from time to time. Know is that bowling styles, ball weights, finger grips are prone to change. This will affect what is considered to be "substantially rigid". Therefore, these known relationships are variable over time and as such render the claim indefinite since the scope of the claim is dependent upon them.

#### ***Claim Rejections - 35 USC § 102***

Claims 33, 34, 36, 38-43 and 45-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowble.

As to claim 33, Fowble shows a finger pad shield **A** with an open end at **e** as shown in fig. 4, a first surface indicated by **b** in fig. 2, a second surface at **d** as indicated in fig. 4. The second surface **d** clearly opposes the first surface **b** and a fastener **a**. The functional limitation pertaining to the intended use such as "for protecting a finger pad from the force" as used in the preamble, "adapted for insertion..." in para. )d and "wherein a force produce in the release..." do not distinguish over the art in a apparatus claim. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body

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and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim. As to claim 34 and 36 respectively, the fastener **a** is a strap, considered a "ring" and a "glove" finger encloser. As to claims 38, 39, 45 and 53, strap **a or d** is capable as functioning as a "limit means" and is considered a "raised surface" when the limitations in the claim are given their broadest reasonable interpretation. As to claims 40, 41, 46-48, 54, 55 and 57, the preamble and paragraph a) are considered shown for the reasons discussed above with respect to claim 33. As to paragraph b) and claims 49, 50, 52 and 56, the finger shield of Fowble is considered substantially "more rigid material" (pg. 1, ln. 35). The shield of the prior art is inherently capable of resisting deformation from a force of a bowling ball during such an intended use. As to claims 42 and 51, the "range within the limit of muscular skeletal development" is the amount of force applied from 0 to where a person can no longer increase the force exerted on an object. Such is inherent in Fowble. It is clear to one skilled in the art of the forces applied and transmitted against forces such as acceleration, gravity and momentum during the delivery of a bowling ball down an alley. However, it has been clearly held that a property or a scientific explanation of the prior art's functioning does not negate the fact that the prior art inherently possessed the claimed element. "Insufficient prior understanding of inherent properties of a known composition does not defeat a finding of anticipation" *Atlas Powder Co. v. Ireco Inc.*, 19 F.3d 1342, 51 USPQ 2d 1943 (Fed. Cir. 1999). As to claim 43, Fowble inherently is capable of spreading a force uniformly over a contact area. More specifically with respect to claims 46-56 and 58, which extensively use means plus function language in attempts to define structure. Fowble shows the function of placing a finger in the shield and having forces exerted between a users finger and the shield be the result of performing a task. These forces between the finger and the shield "form a contact area", "spread force produced" during the task (as recited in claims 46, 48 and 51), spread the fore "uniformly" (claim 47), resist deformation by the materials properties (claims 49, 50, 52 and 56) and spreading over a "widest area" (claim 55).

Fowble meets the limitations of the recited claims. Whereas appellant may recite the shield must be "substantially rigid" and only that it "resist deformation", it is known that the claims must be interpreted given their broadest most reasonable interpretation. In doing such "substantially rigid" and "resist deformation" is so broad as to encompass anything. Nothing about "resist deformation" is assumed to mean that it "does not deform". A piece of paper "resists deformation" of any force applied to it up to a certain point.

More specifically to claims 38 and the "raised surface", nothing in the claim requires with respect to what the surface is raised. As such the claims are again given their broadest interpretation. Further, the strap **a or d** is

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capable of contacting the surface of the bowling ball and limiting the in depth of insertion. Well settled is that if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

### ***Claim Rejections - 35 USC § 103***

Claims 35, 37, 44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowble in view of Pratt.

As to claims 35 and 58, adjustable straps in finger shields and hand protectors in general are old and well known to secure an apparatus so one can achieve a desired fit. This has not been refuted by appellant. As to claims 37 and 44, Fowble fails to discuss any parts of a glove with respect to the use of his finger shield. Pratt shows combining finger inserts with gloves in order to combine the benefits of the insert with those of a gloved hand. To have included the insert of Fowble in a glove would have been obvious in order to protect the finger as well as the hand as a result of the benefits of the glove.

### **(10) Response to Argument**

A.

#### **Standards For Patent Examination**

1.

No comment is deemed necessary to pages 4-10 and to the case law recited pro forma therein. This section is not directed specifically to any claim limitation or rejection set forth by the examiner and amounts to a mere allegation of patentability. Any comment would only serve to cloud the issues of this appeal.

B.

#### **Introduction To Appellants' Arguments**

Examiner's grounds for rejection shows where each and every element recited in the claims is shown or fairly taught by that applied art as set forth in the grounds for rejection above.

Well recognized is that one must take into account what is known in the art as a whole and known to one of ordinary skill in the art. See *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Moreover, skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Lastly, in evaluating a reference, it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In

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re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Held is that one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962). Such knowledge that exists to one of ordinary skill in the art is not based on "self knowledge" as is the position of appellant. While appellant scream foul alleging that the examiner used "personal knowledge" and opinion, it is recognized by the Courts that motivation can come from 1) the teachings of the prior art, 2) the knowledge of persons of ordinary skill in the art and/or 3) the nature of the problem solved. See *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2<sup>nd</sup> 1453 (Fed. Cir. 1998).

C.

1.

Claims 40 to 45 Fail to meet of 35 USC 112

Examiner's rejection meets the standards required first by stating that the claim is indefinite, states why since the terms are subjective and give examples as to how they are subjective because a "maximum natural force" has no definite means for comparison since strength of bowlers, weight of balls and styles of delivery vary in infinite combinations. Merely because the appellant does not agree or does not understand does not render a rejection improper. Applicant has had opportunity to respond to this rejection, first made in the 12/17/2002 non-final office action, on pg. 7 of his 1/14/2003 amendment.

While the appellants complain that the examiner did not explain, the final rejection of 6/18/03 was even more detailed with respect to the position of the office;

"As to claims 40, 42 and 43, "maximum natural force" remains indefinite. Ball weights and bowlers are variables without defined ranges. Further the force is also a function of how a ball is delivered or thrown. As bowler who rolls a ball straight the pins would produce different forces than when he applies spin to the ball. What would be considered to be "substantially rigid" under these condition remains indefinite. Note that a claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of pads was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). As with here both the bowling ball and bowler are or unspecified characteristics and render the claim indefinite. Further the Limitations in a claim must be timeless. The relationship between the ball, bowler and finger pad shield, the product it identifies, is indefinite, uncertain, and arbitrary since the formula or characteristics of the product may change from time to time. Know is that bowling styles, ball weights, finger grips are prone to change. This will affect what is considered to be "substantially rigid". Therefore, these known relationships are variable over time and as such render the claim indefinite since the scope of the claim is dependent upon them."

If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112,

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second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). As such the rejection is deemed proper and should be sustained.

Appellant argues what is discussed in the specification sets forth what is meant by "maximum natural force" (bottom pg. 12 of Brief). However, what is disclosed in the specification does not make definite the claim limitations "substantially rigid to resist deformation from a force produced when a maximum natural force is applied" (cl. 40). One must note that everything can be considered "substantially rigid". A rubber material may be substantially rigid to resist deformation of a child using a 6 lb. ball that is being thrown as a spinner.<sup>1</sup> Plastic may work, but certain types are known to bend. For a large bowler with a 16 lb ball one may have to use steel. Also, something that resists deformation does not mean that it "cannot deform". Once again everything can resist deformation depending upon the condition placed upon it. Lastly, a "maximum natural force" does nothing to help one skilled in the art determine the degree of "rigidity" since this varies depending upon the bowler, ball, style and delivery. Every bowler delivers a different size ball with varying degrees of force depending upon technique. Hence, nothing about the specification helps one skilled in the art determine the metes and bounds of this claim language and the rejection should be sustained.

Simply put, the definition of a term cannot depend on an undefined standard. See *Amgen*, 314 F.3d at 1342 (finding indefinite claim requiring comparison to moving target since the patent failed to direct those of ordinary skill in the art to a standard by which the appropriate comparison could be made). Further see *Datamize, LLC, v Plumtree Software, Inc.* (CAFC, 04-1564, 8/5/2005). A copy of this decision is appended to this answer for the convenience of the Board.

Rule 132 Declaration of Dr. W. Robert Addington, D.O

In the final office action of 1/26/05 the Declaration of Mr. Addington was treated. The declaration was submitted to rebut the rejection under 112. However, held is that expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) Second, it fails to present facts. The declaration renders applicant impressions regarding what he intends to be meant by "the force produced by the release of the ball." This is not fact. Lastly, an affidavit of an applicant as to the advantages of his or her claimed invention is less persuasive than that of a disinterested person. *Ex parte Keyes*, 214

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<sup>1</sup> Note that this type of delivery of a bowling ball is done with the middle finger of the hand leading the delivery of the ball. The ball is released so that the ball spins on its vertical axis as it slides down the oil bowling alley.



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USPQ 579 (Bd. App. 1982),<sup>1</sup> In re McKenna, 203 F.2d 717, 97 USPQ 348 (CCPX 1953). As such, the declaration carries little weight to overcome the grounds for rejection under 112.

The examiners position is upheld in the more recent decision, *Datamize, LLC, v Plumtree Software, Inc.* (CAFC, 04-1564, 8/5/2005) where the definition of a limitation cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics. Held therein is that a reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention. In short, the definition of a term cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics.

3.

Examiner's Rejection Under 35 U.S.C. § 112 under 112 is proper and should be sustained.

This section amounts to mere allegation that the rejection is improper and no further comment is deemed necessary. The examiner's position is set forth in the grounds for rejection and above.

D.

Claims 33, 34, 36, 38-43, and 45-58 are Anticipated By Fowble

The Limits To The Fowble Disclosure

Like appellant's invention, Fowble is limited to a finger protector to protect the finger. Fowble describes the protector being of sufficient length to cover the entire finger, including the finger pad. Page 1, lines 86 - 88. Fowble discloses the material may be made "more rigid," to protect the finger from the task that a user is performing. More particularly it should be rigid enough to "withstand the wear to which they are subjected, while affording better protection" (pg. 1, ln. 29). The fact that the device of Fowble shows features that above and beyond what is being claimed by appellant in its ability to allow accumulated grit or sand leave is immaterial to this grounds for rejection.

Fowble shows raised surface a which is capable of functioning as a limiting means

In Fowble, element "a" is a raised surface from surface b and inherently acts to contact the a bowling ball and to limit the depth the finger protector can be placed in a hole. "Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject

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matter shown to be in the prior art does not possess the characteristics relied on")( In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA)).

Appellant has done nothing to show that element "a" of flowble does not possess the characteristic function of being able to limit the insertion of Fowble's insert into a bowling ball.

In summary, appellant's claims do not recite a specific material so Flowble does not need to show any specific material. Appellant only calls for the device to be "substantially rigid to resist deformation..." which is so broad to encompass any material depending upon the use of a finger protector. Flowble shows "at least one fastener" in his element "d" as called for by appellant's claims. This strap holds the protector in contact with the finger. Note that in viewing how that strap will interact with the hole of a bowling ball it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In the instant case it is reasonable to infer that the element "a" of flowble will not be readily insertable into the hole of a bowling ball and act to limit the depth of the insertion of the finger protector. Lastly, nowhere does Flowble disclose a loose fit. This has been read into the reference by the appellant. The interest of Fowble is to protect the finger as is appellant's invention.

2 .

Fowble anticipates claims under 35 U.S.C. 102.

Examiner has considered all limitation as set forth in the grounds for rejection above. While appellant complains that his functional limitations were not evaluated, such is untrue. Specifically in the 12/17/02 office action the functional limitations were treated as;

The functional limitations pertaining to the intended use such as "for protecting a finger pad from the force" as used in the preamble, "adapted for insertion...and "wherein a force produce in the release..." do not distinguish over the art in a apparatus claim. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation", Kropa v. Robie, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim).

Further it is well settled that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Clearly the examiner considered

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all the limitations of the claims and the appellant has had every opportunity to rebut them, including the functional recitations, and the grounds for rejection should be sustained.

b) Claims 34 and 36.

As set forth in the grounds for rejection above, the at least one fastener is a strap is shown by elements "a" and "d" of Fowble which are a "strap". By the Merriam Webster's definition of a "ring" as a " : a circular band for holding, connecting, hanging, pulling, packing, or sealing, elements "a" and "d" meet this limitation

c) Claims 38 and 39.

As set forth in the rejection above, the "raised surface" extending in a direction away from said finger pad shield and said contact area can be met by element "d". It only needs to be "adapted to limit the depth" and this function is considered to be inherent in element "d". Appellant has not met his burden of showing where this element is not capable of performing this inherent function.

The recited elements in these claims have not been shown in Fowble.

d) Claims 40 – 42.

Inherently, Fowble shows a user applying "maximum natural force" in the use of his device. This force is only related to the intended use of the appellants finger protector and it has been held that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). With respect to the "range within the limit of muscular skeletal development", such a range can be from zero for a person that is paralyzed to several hundred pounds for a body builder. As such, Fowble inherently shows this broad range limitation and the grounds for rejection should be sustained.

e) Claims 38, 39, 45 and 53

9 Claims 38, 39, 44, 45, and 53, recite,

For claims 38, 39, 44 and 45 appellant has merely restated the claims and has not argued where any proposed errors in the grounds for rejection exist. As such no further comment is deemed necessary with respect to these claims.

As to claim 53, it is set forth in the rejection above, the "means to limit the depth" is met by element "d" that inherently performs the function. According to pg. 21 of appellant's specification this limiting means would be his element 26 (as shown in fig. 1) and is equivalent to something that "is a raised surface extending away from the finger pad shield means 14 and the bowler's finger pad when the bowler's finger is placed in the bowler's aid..." The

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strap "d" of Fowble is considered to be an equivalent to what is disclosed in the appellants specification as being a "rasied surface extending away from the finger pad shield". Inherently this raised surface "d" limits the depth of a finger capable of being inserted into a bowling ball hole. Appellant has not met his burden of showing where this element is not capable of performing this inherent function.

g) Claims 49, 50, 52, and 56.

Appellant argues examiners finding of inherency arguing that the examiner did not meet he requirements set forth in the MPEP. However, the examiner has met his burden stating a technical reasoning that reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). This technical reasoning is based upon the structural similarities of the claimed invention and the prior art. This position that structurally similar devices possess the same characteristics in use is affirmed in *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997) where the court affirmed a finding that a prior patent to a conical spout used primarily to dispense oil from an oil can inherently performed the functions recited in applicant's claim to a conical container top for dispensing popped popcorn. The examiner had asserted inherency based on the structural similarity between the patented spout and applicant's disclosed top, i.e., both structures had the same general shape. For that reason, the examiner was justified in his conclusion. As with the instant case, we have structurally similar devices to which the doctrine of inherency has been appropriately applied. As such, the grounds for rejection should be sustained.

E.

Claims 35, 37, 44 and 57 Are Unpatentable In View Of Fowble and Pratt

Pratt shows the use of a finger protectors combination with a glove. The word "motivation" or a word similar to "motivation" does not appear in 35 U.S.C. § 103(a). While a finding of "motivation" supported by substantial evidence probably will support combining teachings of different prior art references to establish a prima facie obviousness case, it is not always necessary. What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a §103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art which would have rendered obvious the claimed subject within the meaning of § 103(a). *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637(Fed. Cir. 1998) (there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant). In the instant case one

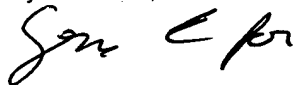
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would combine the teachings of Pratt with Fowble in order to secure the insert to the finger and to afford the entire hand protection as a result of the glove.

Obviousness can be established where there is some teaching, suggestion, or motivation to do so found implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). In the instant case, the problem facing the inventor was to protect and to provide a way for keeping the protection on the fingers during a task. Pratt clearly shows that finger protection is afforded by the combination of a glove with finger inserts like the one shown by Flowble. As such the grounds for rejection is deemed proper and should be sustained.

For the above reasons, it is believed that the rejections should be sustained.

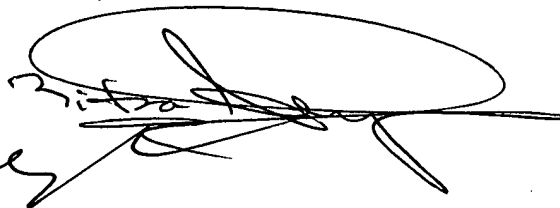
Respectfully submitted,



Bill Pierce

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Mitra Aryanpour



Vishu Mendiratta

